

REMARKS

Claims 1-51 were presented for examination and were pending in this application. In an Official Action dated February 8, 2006, claims 1-51 were rejected. Applicants thank Examiner for examination of the claims pending in this application and address Examiner's comments below.

Applicants herein amend claim 41. These changes are believed not to introduce new matter, and their entry is respectfully requested. Applicants respectfully submit that the new claim is fully supported by the specification and is within the scope of protection to which Applicants believe they are entitled. Reconsideration of the application in view of the above Amendments and the following Remarks is respectfully requested.

THE SPECIFICATION

In response to the Examiner's objection, Applicants state that their November 14, 2005 response has unambiguously set forth where the amendments are located in the specification by identifying the paragraph number to be replaced. MPEP §714 provides that "the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method....Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment." Because Applicants have identified the paragraph numbers to be replaced in accordance with MPEP §714, Applicants respectfully request withdrawal of this ground of rejection.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 41-51 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Regarding claims 41-49, Applicants have amended claim 41 to remove the phrase "being capable of." This amendment is made so as to more clearly define the invention, and not to narrow the scope of protection with respect to the prior art, or with respect to potentially infringing devices. With this amendment, Applicants submit that claim 41 particularly points out and distinctly claims what Applicants regard as the invention. Claims 42-49 depend, either directly or indirectly from claim 41. Based on their dependence on claim 41, claims 42-49 are also believed to be patentable. Accordingly, Applicants respectfully request that the rejections of claims 41-49 under 35 U.S.C. § 112, second paragraph be withdrawn.

Applicants have canceled claims 50 and 51.

REJECTIONS UNDER 35 U.S.C. § 103

Examiner rejected claims 1-3, 16, 21, 24, 25, 41, 42 and 47 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,633,723 to Sugiyama et al. ("Sugiyama") in view of U.S. Patent Application No. 2003/0002068 to Constantin et al. ("Constantin"). This rejection is respectfully traversed.

Independent Claims 1 and 41

With respect to claim 1, the Examiner correctly recognizes that Sugiyama does not disclose a "printing sub-system for receiving and printing standard document formats, wherein said interface is physically coupled to said printing sub-system." (2/8/06 Office Action at 7.) Applicants further note that Sugiyama also lacks the element of "an interface for receiving the time-based media data from a media source, the interface physically coupled to the printing sub-system."

The Examiner states that Constantin "inherently requires that said printing sub-system be physically coupled to some sort of interface" because Constantin allegedly requires "that the document be scanned into computer and/or transmitted electronically to a web, email or network address." (Id.) Constantin's alleged requirement that a document be scanned into computer or that it be transmitted electronically, however, does not require that the interface into which the document is scanned or transmitted is both physically coupled to the printing sub-system and coupled to the multimedia processing system to receive the time based media, as required by claim 1. In fact, Constantin does not disclose the element of "an interface for receiving the time-based media data from a media source, the interface physically coupled to the printing sub-system."

Thus, neither of the cited references teaches all of the elements of the claim. It is not sufficient that the printing sub-system be "physically coupled to some sort of interface", but rather that the printing sub-system is physically coupled to the interface and that the same interface is also coupled to the multimedia processing system. Neither Sugiyama nor Constantin have the required element of "an interface for receiving time-based media data from a media source, the interface physically coupled to the printing sub-system."

In addition, with respect to both claims 1 and 41, the cited art provides no suggestion or teaching to combine the references. The Examiner states that the suggested modification would have been within the ordinary skill in the art. MPEP § 2143.01 states "A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to

combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).”

Obviousness is tested by “what the combined teachings of the references would have suggested to those of ordinary skill in the art.” In re Keller, 642 F.2d 413, 425, 208 U.S.P.Q. 871 (C.C.P.A. 1981). But it “cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). And “teachings of references can be combined only if there is some suggestion or incentive to do so.” Id. Here, the prior art contains none.

Instead, the Examiner relies on hindsight in reaching the obviousness determination. But the courts have said, “To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” W. L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

Applicants respectfully request that the Examiner indicate where support can be found in Sugiyama or Constantin for its statement that the “input that would be received from the printing sub-system of Constantin is simply a type of video signal to be input into said interface” or that the “printing sub-system of Constantin simply provides the required video signal.” (2/8/06 Office Action at 8 (emphasis added).) Applicants submit that the word “video” cannot be found anywhere in Constantin.

In the absence of some teaching or suggestion in the cited references concerning the method of the present invention, the Examiner has presented no more than an improper hindsight reconstruction of the present invention. As stated by the Court of Appeals for the Federal Circuit In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988): "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Even if Sugiyama and Constantin could be combined, despite the failure of the recited art to teach or suggest such a combination, the result would be two separate interfaces: one coupled to Sugiyama's multimedia processing system, the second coupled to Constantin's printing subsystem, rather an interface coupled to both the multimedia processing system and the printing subsystem, as set forth in claim 1.

In conclusion, the cited references do not disclose all of the elements of claim 1, and there is no teaching to combine the references with respect to both claims 1 and 41. Therefore, withdrawal of these grounds of rejection with respect to claims 1 and 41 is respectfully requested.

Dependent Claims 2-3, 16, 21, 24-25, 42, and 47

As claims 2-3, 16, 21, and 24-25 are dependent on claim 1, and claims 42 and 47 are dependent on claim 41, all arguments advanced above with respect to claims 1 and 41 are hereby incorporated so as to apply to claims 2-3, 16, 21, and 24-25, and to claims 42 and 47, respectively. Thus, Applicants respectfully assert that claims 2-3, 16, 21, 24-25, 42, and 47 are also patentable over Sugiyama in view of Constantin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of the dependent claims as well.

Dependent Claims 4-15, 17-20, 22-23, 26-40, 43-46 and 48-49

In paragraphs 14-28 of the Office Action (dated 2/8/06), Examiner rejected the rest of the dependent claims (4-15, 17-20, 22-23, 26-40, 43-46 and 48-49) under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sugiyama in view of Constantin and various other references, including U.S. Patent No. 6,193,658 to Wendelken et al. ("Wendelken") (claims 4-6 and 43-44); Wendelken, U.S. Patent Application Publication 2003/0220988 A1 to Hymel ("Hymel") and U.S. Patent Application Publication 2002/0185533 A1 to Shieh et al. ("Shieh") (claims 7 and 45); U.S. Patent No. 6,118,888 to Chino et al. ("Chino") (claims 8 and 38-40); Shieh (claims 9, 11-12, and 18); U.S. Patent Application Publication 2002/0010641 A1 to Stevens et al. ("Stevens") (claim 10); U.S. Patent No. 5,436,792 to Leman et al. ("Leman") (claims 13-14); Hymel (claims 15, 20, 22, 46, and 48); U.S. Patent Application Publication 2002/0048224 A1 to Dygert et al. ("Dygert") (claims 17, 28-30, and 33-35); Shieh, Hymel, and U.S. Patent No. 5,568,406 to Gerber ("Gerber") (claim 19); Shieh, Hymel, and U.S. Patent No. 4,881,135 to Heilweil ("Heilweil") (claims 23 and 49); U.S. Patent No. 4,807,186 to Ohnishi et al. ("Ohnishi") (claim 26); U.S. Patent No. 6,115,718 to Huberman et al. ("Huberman") (claim 27); U.S. Patent Application Publication 2002/0169849 A1 to Schorath et al. ("Schroath") (claims 31-32); Dygert and Huberman (claim 36); and U.S. Patent No. 4,754,485 to Klatt ("Klatt") (claim 37). These rejections are respectfully traversed.

Claims 4-15, 17-20, 22-23, and 26-40 depend directly or indirectly from claim 1 and incorporate the limitations discussed above with respect to claim 1. Claims 43-46 and 48-49 depend directly or indirectly from independent claim 41 and incorporate the limitations discussed above with respect to claim 41.

Applicants further submit that the multi-functional printing system, including both standard printing and time-based media printing features, is not disclosed or rendered obvious by any of the references Wendelken, Hymel, Shieh, Chino, Stevens, Dygert, Gerber, Heilweil, Ohnishi, or Klatt, either alone or in combination with Sugiyama.

Applicants further respectfully submit that claims 4-15, 17-20, 22-23, 26-40, 43-46, and 48-49 recite patentable subject matter not disclosed or rendered obvious by the cited references, either alone or in combination.

Particularly regarding claim 27, the Examiner correctly recognizes that Sugiyama in view of Constantin does not disclose "that the multi-media processing system is configured to generate a web page representation of the multi-media." (2/8/06 Office Action at 30.) The Examiner states that "Huberman discloses generating a web page representation of multimedia data" because for the "page to exist with multi-media data...it is inherent that said web page is generated." (Id.)

However, Huberman does not disclose "a multimedia processing system coupled to an interface for receiving the time-based media data" that "generates" a web page; it merely "analyzes collections of linked documents (i.e. Web Pages)" that already exist. In fact, Huberman provides no disclosure whatsoever in the cited portions of how the web pages are generated. That a web page may have "multi-media content" does not disclose that such a web page was generated by "a multimedia processing system coupled to an interface for receiving the time-based media data." Thus, none of the listed citations discloses or renders obvious "the multimedia processing system [] configured to generate a web page representation of the multimedia," as recited by Applicants' claim 27.


Based on the above Amendments and Remarks, Applicants respectfully submit that for at least these reasons claims 4-15, 17-20, 22-23, 26-40, 43-46, and 48-49 are patentably distinguishable over the cited references, both alone and in combination. Therefore, Applicants respectfully request that Examiner reconsider and withdraw the 35 U.S.C. § 103(a) rejection.

CONCLUSION

Based on the above remarks, Applicants respectfully submit that the claims presently in this case are now in condition for allowance. Reconsideration and prompt favorable action are therefore solicited.

Respectfully submitted,
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